

PATENT APPLICATION

Attorney Docket: 54391

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Applicant: Ward
Serial No.: 9/655,987
Filed: 9/6/2000
For: Composition for Protecting Work Surfaces from Contamination
Group Art Unit: 1774
Examiner: Dicus, Tamra

REPLY BRIEF FOR APPELLANT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This reply brief is filed in response to the Examiner's answer, dated 10/3/2008, to the appeal, dated 08/25/2008, of the rejection in the above-identified patent application. This brief addresses only those arguments made in the Examiner's answer that were not part of the Examiner's arguments in the office action dated 05/01/2008 rejecting the claims of concern.

First, concerning the rejection of claims 23 and 27 as anticipated by Rubino, the Examiner attempts to counter the examples discussed by Applicant of closed cell foam articles that are not water-impermeable by presenting one example of a closed-cell foam article that is water-impermeable. Even if the specific examples presented by Appellant were disregarded for some reason, the fact that certain articles composed of closed-cell foam may be water-impermeable is obviously not equivalent to showing that all articles composed of closed-cell foam are intrinsically water-impermeable. Appellant submits that in order to sustain a rejection under U.S.C. 102(b), which the Examiner stated was the intended grounds for these rejections, "the mere fact that a certain thing may result from a given set of

circumstances is not sufficient to sustain a rejection for anticipation”. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). Hence, the “ice-cooler” example provided by the Examiner does not invalidate Appellant’s argument that water-impermeability is not intrinsic to the articles taught by Rubino.

Second, concerning the rejection of claims 1, 25, and 28 as unpatentable over Evans in view of cited secondary references, the Examiner asserts that a hydrophobic medium “is incapable of absorbing water”, and hence, the medium taught by Evans must be water-impermeable. The Examiner’s assertion is clearly false. A sheet of hydrophobic material with holes through the sheet is incapable of absorbing water but is clearly water permeable, the water traveling through the pores.

The Examiner discusses ways in which the material of Evans *could* be modified so that “one could very well have made Appellant’s invention”. The issue is not whether the material of Evans **could** be modified to be made water impermeable, but whether the Examiner has pointed to any plausible suggestion that would lead one of ordinary skill to make that change to better fulfill the purpose of the system taught by Evans.

Third, also concerning the rejection of claims 1, 25, and 28 as unpatentable over Evans in view of some secondary references, the Examiner now asserts that the motivation for electrostatically charging the sheet of Evans would not be to secure the sheet against an external surface such as a wall or floor, as the Examiner suggested in the above referenced office action, but to “promote interfacial adhesion” within the sheet itself. The Examiner has not pointed to any teachings in the prior art that interfacial adhesion in the sheets of interest is a problem that needs to be addressed. Furthermore, it is known in the art that water, or any other liquid conductor, neutralizes the static charge, and hence, destroys any such electrostatic interfacial adhesion, and hence, there is no reasonable expectation of success in making the alteration suggested by the Examiner.

In response to Appellant’s argument that if the sheet of Evans were to be charged, that charge would be likely to be quickly neutralized by the liquid spill of interest, the Examiner objects that the claims do not specify any charge persistence time. Appellant submits that the argument in question was made not to suggest that the claims specify any charge persistence

time, but to show that the Examiner's proposed modification of the teachings of Evans would not be operable to achieve the benefits that the Examiner had suggested.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Calvin B. Ward".

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Date: August 7, 2008

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